

REMARKS

The applicant respectfully requests reconsideration in view of the amendment and the following remarks. Support for amended claim 1 can be found on page 3, line 36 to page 4, line 1, items t) and x) from original claim 4, page 9, lines 35 and 36 and page 10, lines 15 to 19 of the application text. Support for newly added claims 30, 31 and 32 can be found in the original claim 4.

The application contains two independent claims (claims 1 and 31). The applicant has added three claims (claims 30 through 32) and cancelled three claims (4, 22 and 29). No fee is required for the three claims added.

Claim 4 is rejected under 35 U.S.C. 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO03/040078 (Slaney), US 6,906,222 is the English equivalent. Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by US 6,137,005 (Hjornevik '005). Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 1273238 A2 (Hjornevik '238). Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by 6,132,796 (Johnsen '796). Claims 1-5, 22-23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0009366 (Foxcroft), in view of Slaney. The applicant respectfully traverses these rejections.

The applicant affirms their election of Group I with traverse. Applicants respectfully traverse the Restriction requirement because the U.S. Patent and Trademark Office has not carried forward its burden of proof to establish distinctness.

In particular, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

As noted by the Examiner, upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to not more than a reasonable number of species in addition to the elected species, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.146.

Furthermore, the applicant respectfully requests that withdrawn claims be rejoined when the Examiner determines that the elected claims are allowable. Clearly claims 14, 15, 21 and 24-27 would require all the limitations of claim 1 and would be allowable if claim 1 is allowable. At least these claims should be rejoined.

Rejections Under 35 U.S.C. 112

Claim 4 is rejected under 35 U.S.C. 112, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant has cancelled claim 4. For the above reasons, this rejection should be withdrawn.

Rejections Under 35 U.S.C. 102(b)

Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Slaney. Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjornevik '005. Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Hjornevik '238. Claims 1-4 and 22-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnsen '796.

At page 5, third paragraph, and page 6, first, third and last paragraphs of the Office Action, the Examiner stated that the preamble "the coating" the Examiner said that the preamble is not given any weight since it does not appear in the body of the claim. The preamble of claim 1 reads "a coated preparation" - this is a term defining substance/matter describing what kind of preparation is claimed, namely one that is coated; it is not defining a purpose. The applicant believes that the preamble should be given weight especially since the body now contains this limitation.

The preamble should be given patentable weight. The applicant claims a coated preparation (see independent claim 1). In some decided cases the preamble of a claim has been denied the effect of a limitation, where the preamble is merely a designation of intended use, In re Van Lint and Miller, 148 USPQ 285, 289 (CCPA 1966). In the other cases, however, the preamble to the claim has been given a limiting effect where the introductory phrase was found essential to point out the invention defined by the claim. In those cases, the preamble gave life, meaning and vitality to the claims, Kropia v. Robie, 187 F.2d 150, 88 USPQ 478 (CCPA 1951).

Whether or not a preamble of intended use constitutes a limitation to the claims is a matter of claim construction which must be determined on the facts of each case in view of the claimed invention as a whole, In re Stencel, 828 F. 2d. 751, 754, 4 U.S.P.Q.2d 1071, 1073 (Fed.

Cir. 1987). A preamble cannot be disregarded simply because it is directed to an intended field of use, In re Duva, 387 F.2d 402, 406, 407, 156 USPQ 90 (CCPA 1967).

A preamble which must necessarily be relied upon to give life and meaning to the remainder of the claim limitations is, itself, a proper claim limitation, Diversitech Corp., 850 F.2d 675, 677, 678, 7 USPQ 2d 1315 (Fed. Cir. 1988), and Perkin-Elmer Corp. v. Computer-vision Corp., 732 F.2d 888, 896, 221 USPQ 669, 675 (Fed. Cir. 1984).

It is clear in the instant case that the preamble should be given patentable weight for the following reasons: the body of the claim requires components A) at least one hydroformate and B) a coating material (see independent claims 1 and 31). These ingredients are required for a coating preparation.

The Examiner will note that all three US references cited by the Examiner were already cited in the instant application (US 6,132,796 as WO 98/19560 (see page 2, lines 13-16 of the applicant's specification); US 6,137,005 as WO 96/35657 (see page 2, lines 5 and 6 of the applicant's specification) and US 6,906,222 B2 as DE 101 54 715 and DE 102 10 730 (see page 1, lines 36 and 37 of the applicant's specification)).

The applicant's claimed invention is directed to
“A coated preparation comprising
component (A) at least one hydroformate of the general formula (I)
(I) $M_3[HCOO]_3 * HCOOH$
where M = Na, K, Cs, NH₄

component (B) at least one coating material selected from the group consisting of specific components (see claims 1 and 31).

None of the cited references discloses preparations, which comprise hydroformates of general formula (I) as well as a coating material according to claims 1 and 31 of the instant invention. Especially, none of the documents discloses a combination with the claimed coating material.

Therefore, these references do not anticipate the claimed invention. For the above reasons, these rejections should be withdrawn.

Rejections Under 35 U.S.C. 103(a)

Claims 1-5, 22-23, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foxcroft in view of Slaney. The instant invention's object was (*inter alia*) to provide a protective mechanism for preparations comprising hydroformates, which mechanism prevents lump formation or aggregation in the animal feed or premix and which also prevents premature release of formic acid salts in the stomach (see page 3, lines 4 to 14 of the applicant's specification). This problem has been solved by the instant invention's combination of hydroformates and a suitable coating material.

Foxcroft does not disclose the specific tetraformates within the applicant's claims 1 and 31. Foxcroft does not contain any hints how the choice of the complex salts composition can prevent the lumping of the feed and at the same time can prevent the premature release of the formic acid's salts in the stomach, either. In particular, the person of ordinary skill in the art can not derive from Foxcroft that the desired properties can be reached by coating the composition.

There is also not the slightest bit of information in Slaney that gives a hint to the person of ordinary skill in the art at the possibility that a coating, let alone the coatings of current claims 1 and 31 as outlined above, could be beneficial in solving the problems underlying the instant invention.

Consequently, neither of the references provide to the person of ordinary skill in the art any hint at all that he could achieve the desired effects by the coated preparations according to the instant invention as outlined in the above formulated claims 1 and 31. For the above reasons, this rejection should be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13311-00055-US from which the undersigned is authorized to draw.

Dated: September 17, 2009

Respectfully submitted,

Electronic signature: /Ashley I. Pezzner/
Ashley I. Pezzner
Registration No.: 35,646
CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P. O. Box 2207
Wilmington, Delaware 19899-2207
(302) 658-9141
(302) 658-5614 (Fax)
Attorney for Applicant